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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE **RECEIVED**

FEB 12 2004

In re Application of:
Gopal B. Avinash

Serial No.: 09/476,684

Filed: December 30, 1999

For: METHOD AND APPARATUS FOR
ENHANCING DISCRETE PIXEL
IMAGES BY ANALYZING IMAGE
STRUCTURE

§ Group Art Unit: 2623
§ Examiner: Dastouri, Mehrdad

§ Atty. Docket: GEMS:0074/YOD
15-GS-5362

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Technology Center 2600

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING
37 C.F.R. 1.8

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as First Class Mail in an envelope addressed to: Mail Stop Petition, Assistant Commissioner for Patents, Washington, D.C. 20231, on the date below:

February 3, 2004

Date

Helen Tinsley
Helen Tinsley

Sir:

**PETITION FOR WITHDRAWAL OF PREMATURE FINAL
REJECTION PURSUANT TO 37 C.F.R. § 1.181 AND M.P.E.P. §1002.02(c)**

Applicants respectfully request that the finality of the Office Action dated December 3, 2003 be withdrawn. The Applicants believe the finality of this Office Action is premature. In the previous Office Action dated June 18, 2003, the Examiner rejected claims 1-39 under 35 U.S.C. § 103(a) as being obvious in view of Polzin et al. (U.S. Pat. No. 6,166,545), among other references. In response to the Office Action of June 18, 2003, the Applicants noted that the reference of Polzin et al. was unavailable to the Examiner under 35 U.S.C. § 103(c).

In the present Office Action, the Examiner maintained the obviousness rejections in view of the reference of Polzin et al. However, presumably in response to the Applicant's comments, the Examiner referenced the Background of Polzin et al., as opposed to the

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previously referenced Summary of the Invention section. In comments provided by the Examiner, the Examiner explains that, in his opinion, the referenced portion of the Polzin et al. reference discusses the subject matter of the Noll et al. reference (which is not directly relied upon by the Examiner in the present rejections), and not the invention of Polzin et al. The Examiner also argues that this position is consistent with the rejections provided in the previous Office Action, i.e., the Office Action dated June 18, 2003.

The Applicant believes that the Examiner modified his rejection to reference the Background section of Polzin et al., instead of the Summary of the Invention section, in the belief that 35 U.S.C. § 103(c) would thereby not apply to the cited text. In particular, the Examiner appears to be under the belief that the cited background material does not constitute “[s]ubject matter developed by another person [presumably Polzin et al.],” as set out in 35 U.S.C. § 103(c). The Applicant does not agree with this position and has traversed in a concurrently filed response to the present Office Action.

Nevertheless, even if the Examiner’s position were to be found correct, it was improper of the Examiner to designate the present response as Final. In particular, the M.P.E.P. 706.07(a) recites:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

As noted by the Applicant, in the Office Action of June 18, 2003 the Examiner cited to virtually the entire Summary of the Invention section of the reference of Polzin et al. The Applicant respectfully notes that the Summary of the Invention section of the Polzin et al.

reference is unquestionably subject matter developed by Polzin et al. and is therefore unavailable under 35 U.S.C. § 103(c).

The Examiner appears to have recognized the applicability of 35 U.S.C. § 103(c) to the Summary of the Invention section and, in response, modified the obviousness rejection to cite to the Background section. The Applicant understands the Examiner's position to be that the Background section of the Polzin et al. reference exclusively discusses the reference of Noll et al. and, therefore, does not constitute subject matter developed by Polzin et al. In particular, the Examiner states that the "teachings of Noll et al is [sic] not the Polzin et al. invention, and consequently is available for use under 35 U.S.C. § 103 rejection."

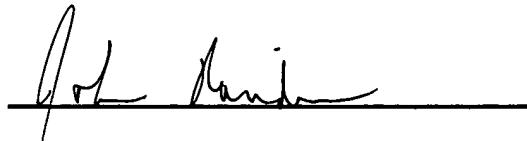
Without commenting on the correctness or error of the Examiner's characterization of 35 U.S.C. § 103(c), the Applicant notes that the Examiner's own actions and comments are inconsistent with designating the present Office Action as Final. As noted above, in the Office Action of June 18, 2003 the Examiner relied upon the Summary of the Invention section of the reference of Polzin et al., which is inarguably subject matter developed by Polzin et al. In the present Office Action, however, the Examiner has altered the obviousness rejection to rely on the Noll et al. reference which, in the Examiner's opinion, is not subject matter developed by Polzin et al. Aside from the impropriety of the Examiner attempting to cite the teachings of Noll et al. by referencing the Polzin et al. reference, it is clear that the Examiner has, in substance, issued a new obviousness rejection in view of the Noll et al. reference.

Therefore, the Applicant believes that the Examiner has introduced a new ground of rejection that is not necessitated by amendment by the Applicant or based on information submitted by in an information disclosure statement. The finality of the present Office Action is, consequently, premature and its withdrawal is respectfully requested.

The Commissioner is authorized to charge the petition fee of \$130.00 as set forth in 37 C.F.R. § 1.17(h), and any additional fees which may be required, to Account No. 07-0845, Order No. 15-GS-5362/YOD (GEMS:0074).

Date: February 3, 2004

Respectfully submitted,



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